

ESTTA Tracking number: **ESTTA544350**Filing date: **06/21/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|---------|---|-------------|----------|
| Name | AstartÃ© Cosmetics, Inc. | | |
| Entity | Corporation | Citizenship | Delaware |
| Address | 300 East 59th Street, Suite 1602 New York, NY 10022 UNITED STATES | | |

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| Attorney information | Louis C. Paul, Esq. Louis C. Paul & Associates, PLLC 150 East 58th Street, 34th Floor New York, NY 10155 UNITED STATES trademarks@cosmeticslaw.com Phone:2122238200 |
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Registration Subject to Cancellation

| | | | |
|-----------------|--|-------------------|------------|
| Registration No | 4256137 | Registration date | 12/11/2012 |
| Registrant | My Shade of Brown Apt 2 651 Vanderbilt Ave Brooklyn, NY 11238 UNITED STATES | | |

Goods/Services Subject to Cancellation

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| Class 039. First Use: 2011/08/01 First Use In Commerce: 2011/08/01 All goods and services in the class are cancelled, namely: Delivery of the cosmetics products, hair care products, beauty products, and skin care samples of others, which can be ordered via e-commerce, namely, online |
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Grounds for Cancellation

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
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Mark Cited by Petitioner as Basis for Cancellation

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| U.S. Registration No. | 3290469 | Application Date | 11/22/2005 |
| Registration Date | 09/11/2007 | Foreign Priority Date | NONE |
| Word Mark | MY SHADE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |

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|----------------|--|
| Goods/Services | Class 003. First use: First Use: 2000/01/12 First Use In Commerce: 2000/01/12 Cosmetic products, namely, lipstick, lipgloss, lip liner pencil, [nail polish,] makeup, foundation, blush, face powder, eye shadow, eyeliner pencil, mascara, concealer; non-medicated skin care preparations, namely, skin serums, lotions for face and body, cosmetic creams for skin care, [beauty gels, facial and body beauty masks and facial or body sprays; exfoliants, body and facial scrubs, chemical peels for the skin,] toners, moisturizers and emollients all for topical application to the skin |
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| Attachments | MSB_Cancellation_Petition.pdf(309106 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|---------------------|
| Signature | /LCP/ |
| Name | Louis C. Paul, Esq. |
| Date | 06/21/2013 |

Astarté Cosmetics, Inc.,)
Petitioner.)

v.)

My Shade of Brown LLC,)
Respondent.)

_____)

/LCP/
Louis C. Paul
Paralegal

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Petitioner, Astarté Cosmetics, Inc. (“Astarté”), a Delaware corporation, located and doing business at 300 East 59th Street, Suite 1602, New York, NY 10022, believes it is and will be damaged by the continued registration of the mark MY SHADE OF BROWN in Registration No. 4,256,137 (“Respondent’s Registration”) to My Shade of Brown DBA My Shade of Brown LLC, and hereby opposes the same.

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|----------------------------|--|
| Mark: | MY SHADE OF BROWN |
| Serial No.: | 85/420,243 |
| Filed: | September 12, 2011 |
| Reg. No.: | 4,256,137 |
| Registered: | December 11, 2012 |
| Int'l Class: | 39 |
| Goods/Services: | delivery of the cosmetics products, hair care products, beauty products, and skin care samples of others, which can be ordered via e-commerce, namely, online. |
| Alleged Date of First Use: | August 1, 2011 |

As grounds for cancellation of Respondent's Registration, it is alleged:

1. Astarté is known for innovative, high-quality goods and unique cosmetic, beauty, and skincare products and related services for women of ethnic skin types ("Astarté's Goods and Services").

2. Astarté is the owner of Registration No. 3,290,469 for the mark MY SHADE ("Astarté's Registration"). A further description of Astarté's Registration follows:

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| Mark: | MY SHADE |
| Serial No.: | 78/759,316 |
| Filed: | November 22, 2005 |
| Reg. No.: | 3,290,469 |
| Registered: | September 11, 2007 |
| Int'l Class: | 3 |
| Goods/Services: | Cosmetic products, namely, lipstick, lipgloss, lip liner pencil, makeup, foundation, blush, face powder, eye shadow, eyeliner pencil, mascara, concealer; non-medicated skin care preparations, namely, skin serums, lotions for face and body, cosmetic creams for skin care, toners, moisturizers and emollients all for topical application to the skin. |
| Date of First Use: | January 12, 2000 |

3. For many years prior to the filing date of Application Serial No. 85/420,243 ("Respondent's Application"), which is the application that matured into Respondent's Registration, and prior to the date of first use alleged in Respondent's Registration, Astarté has designed, developed, marketed, manufactured, promoted, offered and sold cosmetic, beauty and skincare products including lipstick, lipgloss, lip liner pencil, makeup, foundation, blush, face powder, eye shadow, eyeliner pencil, mascara, concealer, and non-medicated skin care preparations (skin serums, lotions for face and body, cosmetic creams for skin care) toners, moisturizers and emollients ("Astarté's Goods") in connection with its MY SHADE mark. More particularly, since at least as early as January 12, 2000, Astarté has extensively and continuously used the MY SHADE mark in connection with the Astarté Goods

4. For over two decades, Astarté has spent considerable time, effort and money in developing its reputation as a leader in cosmetic, beauty and skincare for women of ethnic skin types. As a result of this investment and the popularity and widespread commercial success of its products, including its products offered in connection with its MY SHADE mark, Astarté has developed a tremendous amount of goodwill in its MY SHADE mark.

5. Astarté's use of the MY SHADE Mark has been valid and continuous since at least as early as the dates of first use indicated above and has not been abandoned. Astarté's continuous use of its MY SHADE mark is evidenced by the Combined Declaration of Use and Incontestability under Sections 8 and 15 of the Trademark Act, 15 U.S.C. §1058 and 1065, which is accepted and acknowledged by the United States Patent and Trademark Office on May 16, 2013.

6. Astarté's MY SHADE mark is symbolic of extensive goodwill and consumer recognition built up by Astarté through time and effort in advertising, promotion and sales. The relevant class of the public – namely, women of ethnic skin types (*i.e.*, “women of color”) – has come to associate Astarté with the MY SHADE mark.

7. Astarté's Goods provided in connection with its MY SHADE mark, as well as Astarté's Goods and Services in general, have received widespread success.

8. By virtue of its substantial use, recognition and promotion, Astarté's MY SHADE mark has acquired great value as an indicator of Astarté and Astarté's Goods, and distinguishes them from the goods and services of others.

9. Respondent operates a website at <http://myshadeofbrown.com>, from which Respondent offers to sell and sells beauty products “tailored for women of color” under the mark MY SHADE OF BROWN. See Exhibit A.

10. In view of the substantial similarity of the respective marks and the related nature of the goods of the respective parties, Respondent's mark MY SHADE OF BROWN so resembles Astarté's MY SHADE mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

11. Respondent's MY SHADE OF BROWN mark is likely to cause confusion with the Astarté's MY SHADE mark. Respondent's Registration identifies goods identical to or closely related to Astarté's Goods and Services, detailed above. As such, when the mark MY SHADE OF BROWN is used on or in connection with the services identified in Respondent's Registration, it is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), namely by causing the trade and purchasing public into believing that the cosmetic, beauty and skincare

products delivered under the MY SHADE OF BROWN mark originate with Astarté or are otherwise authorized, licensed or sponsored by Astarté.

12. Respondent has no license, consent or permission from Astarté to use or register marks containing the terms MY SHADE.

13. The first two terms of the mark shown in Respondent's Registration and Astarté's Registration, MY SHADE, are identical.

14. MY SHADE is the dominant part of both Respondent's Registration and Astarté's Registration.

15. Astarté provides cosmetic, beauty and skincare products in connection with Astarté's Registration for the mark MY SHADE.

16. Respondent provides cosmetic, beauty and skincare products in connection with Respondent's Registration for the mark MY SHADE OF BROWN.

17. The goods Astarté provides in connection with Astarté's Registration are identical to the goods Respondent provides in connection with Respondent's Registration.

18. Astarté and Respondent market goods to the same class of the consuming public – “women of color” (*i.e.*, women of ethnic skin types) – and are competitors.

19. Astarté used its MY SHADE mark prior to Respondent's alleged date of first use of the mark MY SHADE OF BROWN as set forth in Respondent's Registration.

20. Astarté used its MY SHADE mark prior to Respondent's first use of any mark consisting of or containing the term MY SHADE.

21. Astarté used the MY SHADE mark prior to the filing date of Respondent's Application.

22. If Respondent is allowed to maintain the registration for the mark in Respondent's Registration, Respondent's right to use the MY SHADE OF BROWN mark nationwide will conflict with Astarté's lawful right to use its MY SHADE mark.

23. By reason of all the foregoing, Astarté has been and will continue to be

injured and damaged by Respondent's Registration and Respondent's use of the mark MY SHADE OF BROWN on or in connection with delivery of the cosmetics products, hair care products, beauty products, and skin care samples of others.

24. In view of Astarté's prior rights in the MY SHADE mark, Respondent is not entitled to registration of the MY SHADE OF BROWN mark pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, Astarté prays that Respondent's Registration be cancelled.

Dated: June 21, 2013

Respectfully submitted,

LOUIS C. PAUL & ASSOCIATES, PLLC
Applicant's Attorneys

/LCP/

By:

Louis C. Paul

150 East 58th Street, 34th Floor
New York, NY 10155
Tel – 212.223.8200
Fax – 212.233.8259

Exhibit A



<https://twitter.com/MyShadeofBrown>



<https://www.facebook.com/MSBBeauty?ref=ts>



<http://instagram.com/MyShadeofBrown>



<http://myshadeofbrown.tumblr.com/>



<http://pinterest.com/myshadeofbrown/>

MY SHADE OF
brown

<https://www.myshadeofbrown.com/>

THE PILLOW BOX <https://www.myshadeofbrown.com/shop/pillow-box>

SHOP <https://www.myshadeofbrown.com/shop>

THE BEAUTY COUNTER <http://myshadeofbrown.tumblr.com/>

BRANDS <https://www.myshadeofbrown.com/shop/brands>

ABOUT US <https://www.myshadeofbrown.com/shop/about>

MY SHADE OF
brown

Beauty Samples Tailored For Women of Color



<https://www.myshadeofbrown.com/shop/>

CERTIFICATE OF SERVICE

I hereby certify that on June 21, 2013, copies of the foregoing PETITION FOR CANCELLATION are being served upon (i) Ms. Magdaline Adefris, CEO of My Shade of Brown LLC, and the correspondent listed in records of the United States Patent and Trademark Office, and (ii) Mr. Eliot Yaxley, an individual, who in correspondence with Petitioner, identified himself as the Chief Operating Officer of My Shade of Brown LLC, by

- (a) depositing one copy thereof in the United States Mail, first-class postage prepaid to each of the addressees listed below; and
- (b) sending a copy thereof by e-mail to each of the addressees listed below.

My Shade of Brown LLC
651 Vanderbilt Avenue, Apt. 2
Brooklyn, New York 11238-3829
Attn: Magdaline Adefris, CEO
m@myshadeofbrown.com

Eliot Yaxley
26 Butler Place
Brooklyn, NY 11238
support@myshadeofbrown.com

Dated: June 21, 2013

By: /LCP/
Louis C. Paul